

Application Serial No. 09/879,418  
Reply to Office Action dated December 4, 2003

**REMARKS/ARGUMENTS**

Initially, the Applicant would like to thank Examiner Corbin for the time taken to discuss this application during an interview on March 3, 2004. During the interview, it was brought to the attention of the Examiner that these product claims were originally acted upon in the parent application, with the broadest claims 30-32 being previously rejected based on the teachings of Roush in view of Hemann in view of Holtz. Additional references were applied for the remaining claims. In any case, for the product claims, no less than three references were utilized and no amendments were made to the claims. As the present case only relies upon the Holtz patent (U.S. Patent No. 5,510,130) utilized as a third reference in the prior rejection, it is respectfully submitted that the finality of the Office Action is premature. Again, the Applicant did not amend the claims in any fashion which necessitated a change in the rejection. In addition, the secondary reference to Schwab et al. (U.S. Patent No. 5,338,556) was not at all previously applied in the prior case. The Examiner has further introduced a new rejection in the application in rejecting claims 30-37 under 35 U.S.C. § 112, second paragraph. Therefore, the Applicant initially requests withdrawal of the finality of the Office Action.

As claim 30 has been amended in a manner suggested by the Examiner, the withdrawal of the formal rejection of claims 30-37 is respectfully requested. In addition, the Applicant has amended the specification on page 1 to reflect the parent application data as outlined in section 6 of the Office Action.

At present, claims 30-34 and 37 stand rejected under 35 U.S.C. § 103 as being unpatentable over Holtz et al. Patent No. 5,510,130. During the interview conducted in this case, the Applicant's representative emphasized in a manner successful in connection with the method claims of the parent application that a major distinction between the present invention and the known prior art is that the discernible cooked grain bits of the

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invention stem from the original grains utilized to fabricate the cooked cereal dough. That is, the cereal dough is formed in a manner that enables discernible cooked grain bits to be retained from the original grains. Certainly, it is understood that these differences can be more clearly brought out in method claims, as done in connection with the parent application. However, it is also respectfully submitted that this distinction sets forth differences between the resulting product and the prior art as will be more fully discussed below.

In discussing the distinctions between the food product of the present invention and the applied prior art, reference is particularly made to the limitations of claim 30 as amended. That is, it was agreed with the Examiner that claim 30 could more particularly point out and distinctly claim the invention concerning the discernible cooked grain bits being from the grains utilized to make the cooked cereal dough. To this end, claim 30 now recites that the food product is fabricated from a cooked cereal dough made from a quantity of grain. The food product must have discernible cooked grain bits that are constituted by part of the quantity of grain. To this end, the discernible cooked grain bits must be made from the original quantity of grains utilized to make the cooked cereal dough. In addition, the claim requires that the discernible cooked grain bits be dispersed through the cooked cereal dough and at least 1 mm<sup>2</sup> in area in the amount of least 30 per gram.

Since the discernible cooked grain bits are from the quantity of grain used to make the cooked cereal dough, this results in a distinct product from that produced by adding or embedding additional grains during a subsequent production step. In connection with the Holtz et al. patent, cereal flakes are produced by taking a dry mix comprising cereal grain, a plasticizer and water and performing an initial cooking step in order to produce a cooked cereal dough. After the cooked cereal dough is produced, edible matter is introduced into the cooked cereal dough. Column 9, lines 64+

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specifically state that the edible matter is not necessarily cooked prior to introduction into the secondary forming step and will not be substantially cooked therein. This is quite unlike the present arrangement wherein the discernible grain bits are formed in connection with the cooked cereal dough such that they are cooked with the cereal dough. However, the Holtz et al. patent does mention that the edible matter embedded into the cereal flake can be a cooked grain (see column 4, lines 41-54). In addition, further edible matter can be attached to the surface of the produced flake as discussed in column 6, lines 22-28. Regardless, it must be perfectly clear that the edible matter in Holtz et al. must be subsequently added to a pre-formed cooked cereal dough, unlike that of the present invention. For this discussion, it is assumed that the edible matter disclosed in Holtz et al. is discernible, although this is not explicitly stated in the prior art patent document.

During the interview conducted with the Examiner, it is believed that the Examiner recognized that the grains embedded in accordance with the Holtz et al. patent do not stem from the original quantity of grain utilized to make the cooked cereal dough. However, the Examiner expressed his concern that this distinction does not lend itself well to the product claims, as opposed to the allowed method claims. To this end, the Applicant would like to emphasize that the product claims of the present application clearly contain structural differences from that of the prior art. First of all, it is respectfully submitted that the discernible cooked grain bits in accordance with the present invention would be different in structure to that of grain bits which are subsequently embedded in a cooked cereal dough in accordance with the prior art. That is, the discernible cooked grain bits of the present invention have undergone various processes with the cereal dough such that the shape and overall structure (internal and external) of the discernible grain bits necessarily change.

It is important to note that this case is not concerned with a design patent of how a product looks such that, even if one could further develop the process disclosed by Holtz et al. such that the resulting product looks like the product of the present invention in

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appearance, the fact of the matter is the structural features of the products would be different. More specifically, the food product of the present invention includes discernible cooked grain bits that constitute part of the quantity of grain used to make the cereal dough. This is a specific structural limitation which is clearly not found in the Holtz et al. patented arrangement. No matter how one would embed the grains in accordance with the Holtz et al. patent, the resulting product would still not have this specific structural feature. Even assuming that a product made in accordance with the present invention and that in accordance with the Holtz et al. patent were made visually similar such that a consumer could not note the distinctions between the two products by simply viewing the products, this would not equate to the two products being structurally the same. Like any product claim, there are structural elements which makeup the product and these structural elements are simply different between the present invention and the known prior art. By way of example, two pens may look the same, but have different springs that could establish a patentable difference. Even though a consumer may not be able to visually ascertain the specific structural differences, this does not equate to the inability to distinguish whether a particular product is structured in accordance with the present invention, the Holtz patent or some other patent on any type of similar product. That is, even though a product made in accordance with the present invention and the known prior art may look similar and differences therein may not be readily ascertainable from a brief review of the products, there are structural differences between the two products which could be verified. Therefore, it is respectfully submitted that the product of the present invention has different components than the prior art. More specifically, claim 30 requires a structural limitation that the discernible cooked grain bits be constituted by part of the quantity of grain used to make the cooked cereal dough, with this being a specific structural feature to the product claim which is not taught or suggested in the prior art. This structural difference results in a different product from that disclosed in the prior art such that it is respectfully submitted that the limitations of claim 30 are patentably distinct from the Holtz et al. arrangement.

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Claim 30 also includes other limitations not specifically disclosed or suggested in Holtz et al. For instance, claim 30 requires that the discernible grain bits be dispersed in the cereal dough in the amount of at least 30 per gram. The Applicant does not contend that one could experiment with the Holtz et al. arrangement so as to vary the amounts of embedded edible material. However, there is clearly no specific disclosure to this particular amount of dispersed grain bits and it is submitted that there must be some motivation for one to experiment in modifying the amount per gram. That is, even assuming that one experimented with the Holtz et al. arrangement and produced a product with grain bits in the amount of, say, 20 per gram, why would one of ordinary skill in the art look to further experiment to produce at least 30 per gram. The Examiner refers to some "optimum number of grain bits per gram", but the prior art does not disclose this feature. For all that is known of the prior art, Holtz et al. may only desire less than 10 per gram. In any case, without a specific teaching, it is respectfully submitted that this feature should be given more patentable weight and some motivation or teaching in the art should be referenced if the Examiner is going to reject this feature as being obvious. Again, one of ordinary skill could experiment with the Holtz et al. arrangement, but why experiment to reach the amount of at least 30 per gram without using hindsight of the present invention.

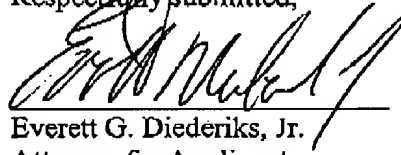
Finally, it is respectfully submitted that the dependent claims in this application further distinguish the present invention from the known prior art. In particular, claim 37 specifies that the food product takes the form of a mini biscuit. The Examiner has equated the claimed mini biscuit to a pellet disclosed in the Holtz et al. patent. These pellets are basically cut sections of a rope of extruded cereal dough, with the pellets being subsequently flaked as discussed in Holtz et al. in, for example, column 10, lines 37-58. Regardless, the pellets are not an end product and they are certainly not mini biscuits.

In view of the above remarks and the amendments to the claims, reconsideration of the application is respectfully requested. More specifically, it is respectfully submitted that the Applicant has amended independent claim 30 to clearly set forth a specific structural limitation not found in the prior art such that allowance of the claims and

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passage of the application to issue are respectfully requested. If the Examiner should have any additional concerns regarding the allowance of this application, he is cordially invited to contact the undersigned at the number provided below to further expedite the prosecution.

Respectfully submitted,



Everett G. Diederiks, Jr.  
Attorney for Applicant  
Reg. No. 33,323

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**DIEDERIKS & WHITELAW, PLC**  
12471 Dillingham Square, #301  
Woodbridge, VA 22192  
Tel: (703) 583-8300  
Fax: (703) 583-8301